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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/902,048	07/10/2001	Michael Lee Vatter	8163	7755

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THE PROCTER & GAMBLE COMPANY
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EXAMINER

WANG, SHENGJUN

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 04/07/2004

17

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 20040402

Application Number: 09/902,048
Filing Date: July 10, 2001
Appellant(s): VATTER, MICHAEL LEE

Kenya Pierre
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed May 7, 2003.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The rejection of claims 1-12 stand or fall together because appellant's brief include a statement that this grouping of claims stand or fall together. See 37 CFR 1.192(c)(7).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

US Patent 5,654,362	Schulz, Jr. et al.	August 5, 1997
US Patent 6,071,503	Drechsler et al.	June 6, 2000

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

1. Claims 1-12 are rejected under 35 U.S.C. 103(a)

These rejections are fully set forth in prior office action, paper No. 13.

(11) Response to Argument

Schulz Jr. et al. teach silicone oils and solvents thickened by silicone elastomers. The elastomers are made by crosslinking silicone-containing precursors (see col. 2, lines 1-59). The silicone oils include polymethylsiloxane, also known as dimethicone (see col. 4, lines 28-45). Common ingredients to be used with the elastomers of Schulz include propylene glycol (see col. 5, lines 1-5). Glycol functional siloxane fluids are taught as useful with the elastomeric compositions, meeting the limitation of a dimethicone copolyol (see col. 4, lines 45-55). Schulz Jr. et al. teach that the compositions are useful for personal and facial cleansers and that they function as color cosmetic removers (see col. 7, lines 41-60). Additionally, Schulz Jr. et al. teach that the compositions are useful as delivery systems for oil and water-soluble substances such as vitamins. Table I includes an emollient (see col. 6, lines 44-67). Further, Schulz Jr. et al. teach composition comprising the elastomers as powder (see column 2, lines 11-21, examples III, col.

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7, lines 34-60 and claim 12). Schulz Jr. et al. do not teach expressly method of makeup removal that specifically includes transfer resistant makeup as well as composition that include a substrate as a tissue.

However, Drechsler et al. teach transfer resistant cosmetic compositions. The compositions of Drechsler contain a silicone gum or resin base (see the examples 1 and 2, col. 15, line 20 through col. 16, line 30). Drechsler et al. teach that the compositions may be removed by applying petrolatum or a dimethicone-based cosmetic remover to the skin or lips and rubbing the area gently with a tissue (see col. 15, lines 15-18).

It would have been prima facie obvious to one of ordinary skill in the art, at the time the claimed invention was made to have modified the compositions and method for makeup removal as taught by Schulz by removing transfer resistant makeup with the further use of a tissue in order to benefit from the removal of transfer resistant makeup as taught by Drechsler.

Appellants argue that the cited references fails to suggest the claimed invention because the references fails to teach or suggest appellant's elastomer having a particle size about 10 to about 200 micron or from 10 to about 80% solvent having solubility parameter of less than or equal to about $9 \text{ (cal./cm}^3)^{1/2}$. The arguments are not convincing. Appellants do not dispute that the elastomer disclosed by Schulz is within the scope of the elastomers herein. In fact, appellants admit that Schulz's elastomers are within the scope of the elastomers herein employed (see page 6, lines 27-30 in the specification). Further, appellant concede that the size of the powder disclosed by Schulz falling within appellant's particle size range (page 4, the second paragraph of the appeal brief). As to the particular solvent, note the solvents herein defined cover most of the commonly used oils in cosmetic. (See, pages 9-10 here in the specification). Such solvents

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are mentioned both by Schulz et al and Drechsler as useful ingredients. The only limitations have not expressly taught by the cited prior arts are the particular amounts of the elastomers and solvent. However, Schulz Jr. et al. teach the elastomers may be used for makeup removal and may be incorporated with solvent. And Drechsler et al. teach that the transfer resistant makeup compositions may be removed by applying petrolatum or a dimethicone-based cosmetic remover to the skin or lips and rubbing the area gently with a tissue (see col. 15, lines 15-18). Therefore, it would have been prima facie obvious to employ the elastomers of Schulz in a dimethicone based makeup remover. It is well settled that an optimization of a result effective parameter, e.g., optimal amounts of a cosmetic ingredients, is considered within the skill of the artisan. See, In re Boesch and Slaney (CCPA) 204 USPQ 215. There is no issue of “pick and chose.”

In response to appellant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation, and suggestion are found both in the cited references and in the knowledge generally available to one of ordinary skill in the art. Particularly, the cited references teach the elastomers herein are useful for makeup removal, and the solvent herein are useful for transfer resistant makeup removing composition, or the wipe containing the same (taught in the references). It is prima facie obvious for one of ordinary skill in the art to combine two compositions each of which is taught in the prior art to be useful for same purpose in order

to form third composition that is to be used for very the same purpose; idea of combining them flows logically from their having been individually taught in prior art; thus, the claimed invention which is a combination of two known makeup removing agents sets forth prima facie obvious subject matter. See In re Kerkhoven, 205 USPQ 1069. Further, it is well settled that an optimization of a result effective parameter, e.g., optimal amounts of a cosmetic ingredients, is considered within the skill of the artisan. See, In re Boesch and Slaney (CCPA) 204 USPQ 215. (knowledge generally available to one of ordinary skill in the art).

Appellant further contend that the cited references fails to teach or suggest appellant's claimed cosmetic removing wipe. The arguments are not persuasive for reasons as discussed above. With respect to the employment of tissue in combination with the elastomer composition to form a wipe, note Drechsler discloses that makeup removal compositions are well known to be made into a wipe for convenient. Therefore, it would have been obvious to one of ordinary skill in the art to incorporate the elastomers-containing makeup removing composition into a tissue to form a wipe.


For the above reasons, it is believed that the rejections should be sustained.

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SHENGJUN WANG
PRIMARY EXAMINER

Respectfully submitted,

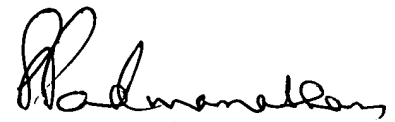

Shengjun Wang
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April 3, 2004

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